

REMARKS

After entry of this Amendment, the pending claims are claims 1-17, 20-31 and 34-38. The Office Action dated June 14, 2007 has been carefully considered. Claims 1, 2, 25 and 26 have been amended. Claims 3-5, 10, 20-24 and 34-38 were previously withdrawn as being drawn to a non-elected species. Claims 18, 19, 32 and 33 have been canceled. Claims 39-42 were previously canceled as being directed to a non-elected invention based on the understanding that the claims would only be restricted to the elected species if no generic claim is held allowable. Claims 43-45 are new. No new matter has been added. Reconsideration and allowance of the present application in view of the above Amendments and the following Remarks is respectfully requested.

In the Office Action dated June 14, 2007, the Examiner:

- rejected claims 1, 2, 6-9, 11, 12, 14-19 and 25-33 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,148,699 to Han ("Han").
- rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Han in view of U.S. Patent Application Publication No. 2002/0188301 to Dallara *et al.* ("Dallara").

INDEPENDENT CLAIM 1

Independent claim 1 has been rejected as being anticipated by Han. As amended, independent claim 1 requires, *inter alia*, a tool comprising a drive shaft having proximal and distal ends, an outer sleeve engaging portion, a fastener engaging portion associated with the drive shaft distal end, the fastener engaging portion comprising a first surface configured to axially engage a fastener and a second

surface configured to rotationally engage the fastener, and an outer sleeve comprising a distal end which is sized and configured to contact either a bone plate or a bone surface.

Han discloses a screwdriver comprising a shaft 14, the shaft 14 having a handle 12 affixed thereto at one end and a drive bit 16 for engaging a screw at the other end. Han further discloses a screw engaging device 20, the screw engaging device 20 being (i) slidably disposed about the shaft 14 of the screwdriver and (ii) sized and configured to engage the screw. The screw engaging device 20 includes a main sleeve 40 having an outer threaded portion 42 at its rear end, for engaging an end sleeve 50.

It is respectfully submitted that Han does not disclose, teach or suggest a tool comprising a drive shaft having proximal and distal ends, an outer sleeve engaging portion, a fastener engaging portion associated with the drive shaft distal end, the fastener engaging portion comprising a first surface configured to axially engage a fastener and a second surface configured to rotationally engage the fastener, and an outer sleeve comprising a distal end which is sized and configured to contact either a bone plate or a bone surface. Rather, Han discloses a shaft having a drive bit on an end thereof for engaging a fastener and a screw engaging device slidably disposed on the shaft for engaging the fastener. It is respectfully submitted that there is absolutely no disclosure, teaching or suggestion of providing an outer sleeve, the outer sleeve being sized and configured to contact either a bone plate or bone surface. The distal end of the so-called outer sleeve is mounted on the threaded portion of the so-called fastener driving portion. As such, it cannot contact either the bone plate or the bone surface.

Therefore, for at least the reason identified above, it is respectfully submitted that Han does not disclose, teach, or suggest all of the limitations of independent claim 1. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Furthermore, as claims 2, 6-9 and 11-17 all depend from independent claim 1, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 2, 6-9 and 11-17 is also respectfully requested.

With respect to claim 13 which was rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Dallara, it is respectfully submitted that Dallara does not overcome the shortcomings of Han. Dallara was cited for the proposition that it would be obvious for one of ordinary skill in the art to incorporate a roughened surface. Without addressing the merits of this argument, it is respectfully submitted that, for at least the above-identified reason, neither Han or Dallara, either along or in combination, disclose, teach or suggest all of the limitations of dependent claim 13. Thus, it is respectfully submitted that dependent claim 13 is allowable over the cited prior art. Withdrawal of this rejection and allowance of dependent claim 13 is respectfully requested.

Moreover, claims 3-5, 10 and 20-24 were withdrawn as being directed to a non-elected species based on the understanding that the claims would only be restricted to the elected species if no generic claim is held allowable. It is respectfully submitted that independent claim 1 is generic and, as such, claims 3-5, 10 and 20-24 should be allowed as well.

INDEPENDENT CLAIM 25

Independent claim 25 has been rejected as being anticipated by Han. As amended, independent claim 25 requires, *inter alia*, a tool comprising a drive shaft having a fastener engaging end and a sleeve engaging portion, the fastener engaging end comprising a rotational engagement portion and an axial engagement portion, the tool further comprising a sleeve having a distal end which is sized and configured to contact either a bone plate or a bone surface.

As previously described above in connection with independent claim 1, it is respectfully submitted that Han does not disclose, teach or suggest a tool comprising a drive shaft having a fastener engaging end and a sleeve engaging portion, the fastener engaging end comprising a rotational engagement portion and an axial engagement portion, the tool further comprising a sleeve having a distal end which is sized and configured to contact either a bone plate or a bone surface. It is respectfully submitted that there is absolutely no disclosure, teaching or suggestion of providing a sleeve, the sleeve being sized and configured to contact either a bone plate or bone surface. The distal end of the so-called sleeve is mounted on the threaded portion of the so-called fastener driving portion. As such, it cannot contact either the bone plate or the bone surface.

Therefore, for at least the reasons identified above, it is respectfully submitted that Han does not disclose, teach, or suggest all of the limitations of independent claim 25. Withdrawal of this rejection and allowance of independent claim 25 is respectfully requested.

Furthermore, as claims 26-31 all depend from independent claim 25, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 26-31 is also respectfully requested.

Moreover, claims 34-38 were withdrawn as being directed to a non-elected species based on the understanding that the claims would only be restricted to the elected species if no generic claim is held allowable. It is respectfully submitted that independent claim 25 is generic and, as such, claims 34-38 should be allowed as well.

INDEPENDENT CLAIM 43

Newly added independent claim 43 requires, *inter alia*, an inner shaft for axially engaging a bone fastener, an outer shaft for rotationally engaging the bone fastener and an outer sleeve for contacting either a bone plate or a bone surface which further comprises an outer shaft engaging portion such that the outer shaft may translate linearly within the outer sleeve when the outer sleeve engaging portion rotationally engages the outer shaft engaging portion.

For reasons similar to those described above in connection with independent claim 1, it is respectfully submitted that Han does not disclose, teach or suggest an inner shaft that is configured to axially engage a bone fastener, an outer shaft that is configured to rotationally engage the bone fastener, and an outer sleeve for contacting either a bone plate or a bone surface. It is respectfully submitted that there is absolutely no disclosure, teaching or suggestion of providing an outer sleeve, the outer sleeve being sized and configured to contact either a bone plate or bone surface. The distal end of the so-called

outer sleeve is mounted on the threaded portion of the so-called fastener driving portion. As such, it cannot contact either the bone plate or the bone surface.

Therefore, for at least the reasons identified above, it is respectfully submitted that Han does not disclose, teach, or suggest all of the limitations of independent claim 43. Allowance of independent claim 43 is respectfully requested.

Furthermore, as claims 44 and 45 both depend from independent claim 43, it is submitted that these claims are equally allowable. Allowance of claims 44 and 45 is also respectfully requested.

CONCLUSION

No fee is believed due with this submission. If, however, the Commissioner determines otherwise, the Commissioner is authorized to charge any fees which may now or hereafter be due in this application to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

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Respectfully submitted,

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